

Appin. No. 10/825,603

New Attorney Docket No.: 8109.005.US

REMARKS**Remarks Regarding Group Election**

In the Office Action, restriction is alleged to be required, under 35 U.S.C. § 121, to one of the following groups of claims:

Group I: Claims 1-14, 17, 20 and 25-27, drawn to an isolated peptide (class 530, subclass 328);

Group II: Claims 15, 16, 18 and 19, drawn to a method of isolating peptide (class 530, subclass 344);

Group III: Claims 21-24, drawn to a method of treatment with a peptide (class 530, subclass 2);

Group IV: Claim 28, drawn to an isolated antibody to a peptide (class 424, subclass 139.1); and

Group V: Claims 29-30, drawn to an isolated nucleic acid that encodes peptide (class 435, subclass 320.1).

As recited under M.P.E.P. 803, restriction is appropriate only when the groups can be shown to be distinct and there would be a "serious burden" placed on the Examiner to examine more than one group of claims. No such serious burden has been established and applicant respectfully requests that this restriction be withdrawn.

All of the claim groups relate to certain isolated peptides. Accordingly, it would appear that a search of one group relating to these peptides would necessarily include a search of all other groups. An increased searching burden is not apparent. The examiner's comments in the Office Action add nothing to support an increased searching burden, but merely recite statements from the Manual of Patent Examining Procedure ("MPEP"). Merely reciting text from the MPEP does not meet the burden of establishing a *prima facie* case for restriction. No comments are provided as to why a search burden of all groups is serious and, thus, a *prima facie* case for a restriction requirement has not been met.

A restriction requirement is imposed "only" when it would be a serious burden on the examiner to examine all of the claims at once. No serious searching burden has been established

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and, thus, the burden to impose the restriction has not been met and remains with the PTO. Withdrawal of the restriction and examination of all claim groups is respectfully requested.

Remarks Regarding Species Election

In the Office Action, the species SEQ ID Nos. 1, 2, 3 and 5 are alleged to be distinct searching species because, allegedly, each sequence has a different structure. Restriction is again imposed on Applicant, under 35 U.S.C. §§ 121, to one of these alleged species for any of the Groups I-V which are elected. Applicant respectfully traverses this requirement.

The restriction has been imposed on Applicant because, allegedly, the sequences are different in structure (see Office Action, page 7). However, there are no disclosures within the application establishing whether the sequences are different in structure or not. This was an assumption by the examiner, which is unsupported by any facts of record. If the examiner is aware of facts to support this conclusion, applicant respectfully request that such facts be made of record in the form of an Examiner's Affidavit, so that Applicant may have a full and fair opportunity to respond. Absent that affidavit, Applicant requests that the species restriction be withdrawn.

Furthermore, PTO has already established that it is not a serious burden to examine up to ten sequences within a single application (see MPEP 803.04). The only exception to this rule, as noted in the MPEP (803.04), is when the sequences are unrelated and complex in nature. That is not the case here. Applicant's sequences are short, the longest being nine amino acids, and contain overlapping sequences. For example, SEQ ID No. 3 is totally encompassed within SEQ ID Nos. 1, 2 and 5. Therefore, any searching of any one of Applicant's sequences would necessarily be included in every other search. Thus, there can be no increased searching burden. Applicant respectfully requests that the entire species restriction be withdrawn.

Remarks Regarding Generic Claim

Applicant has provisionally elected SEQ ID No. 3, which is generic to SEQ ID Nos. 1, 2 and 5. Applicant respectfully requests that, should the species restriction not be withdrawn, the remaining species be examined in this application.

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Conclusion

The application is in condition for examination and the prompt issuance of an Office Action is respectfully requested. If there are any additional fees due with the filing of this Response, including any fees for an extension of time, applicant respectfully requests that extension and also requests that any and all fees due be charged to Deposit Account No. 14-1437 referencing Attorney Docket No. 8109.005.US.

Respectfully submitted,
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Date: June 26, 2006

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